

REMARKS

Applicant would like to thank the Examiner for consideration of the subject application. In prior office action dated April 1, 2004, the drawings were objected to under 37 CFR §1.83(a). Applicant notes with thanks that the drawings filed on 6 September 2003 have been accepted by the examiner. Applicant further notes that objection to claims 1, 6, and 11 have been removed.

Summary of claimed subject matter

Claim 1 is directed to a device for assisting an archer in shooting an arrow from a bow while aiming the arrow at a target, wherein the device comprises a vertical slide 26, a vertical slide mount 28 slidably engaged with the vertical slide 26 to allow movement of the vertical slide 26 in a vertical direction, a horizontal bar 24 adapted for receiving an aiming sight 32 and engaged with at least one of the vertical slide 26 and vertical slide mount 28 to allow movement of the horizontal bar in a horizontal direction, and a removable adjustment member 30 that adjusts the aiming sight 32 in controlled, finite, repeatable, increments in the horizontal and vertical direction relative to a fixed point on the bow 12. (see Figures 1-3, page 4, lines 10-30)

Claim 6 is directed to a device for assisting an archer in shooting an arrow from a bow 12 while aiming the arrow at a target, wherein the device comprises a bar 24 adapted for receiving an aiming sight 32, a slide 26 slidably engaged with the bar 24 to allow movement of the bar 24 in an approximately horizontal direction, a slide mount 28 slidably engaged with the slide 26 to allow movement of the slide 26 in an approximately vertical direction, and a removable adjustment member 30 that adjusts the aiming sight in controlled, finite, repeatable, increments in the approximately horizontal and vertical direction relative to a fixed point on the bow 12, wherein the adjustment member 30 includes a first coupling 72-76 and 82-86 to couple the adjustment member 30 to the bar 24 and at least one of the slide 26 and slide mount 28 (see Figures 2,3 and 5-7, and page 4 line 10 – page 5 line 11).

Claim 15 is directed to an aiming device for assisting an archer while aiming an arrow at a target, wherein the device comprises a sight 32 assembly attached to a bow 12,

horizontal means 24 for adjusting the sight 32 assembly in a substantially horizontal plane, vertical means 26 and 28 for adjusting the sight 32 assembly in a substantially vertical plane, and a removable adjustment member 30 that adjusts the aiming sight 32 in controlled, finite, repeatable, increments in the horizontal and vertical direction relative to a fixed point on the bow 12 without disassembling the horizontal or vertical means (see Figures 2, 3 and 5-7 and page 4 line 10 – page 5 line 11).

Grounds of rejection

All pending claims are rejected under a single ground of rejection under 35 U.S.C.

§102(b). The office action states that claims 1-8, 10 and 15-17 are rejected under 35

U.S.C. 102(b) as being anticipated by Sappington (US 5,414,936). In support of the

rejection, the action identifies “Fig. 2, bracket 83, slide 51, support 101 and bracket 89”

as a removable adjustment member, a threaded “axial knob 133” as a first coupling, and

threaded “cap 73” as a second coupling. The action further asserts that the limitation

“removeable adjustment member” is not structurally limiting.

Argument

Each of the independent claims include limitations that are not shown or described in the Sappington reference and which have not been identified with corresponding structure in the Sappington reference. For example, Claim 15 requires “a removable adjustment member that adjusts the aiming sight in controlled, finite, repeatable, increments in the horizontal and vertical direction relative to a fixed point on the bow **without disassembling the horizontal or vertical means.**” (emphasis added)

The basis for the rejection of all the claims, including claim 15, is the assertion that the claim limitation “removeable” and “without disassembling the horizontal or vertical means, do not limit the claims.

Although Sappington shows and describes an adjustable bow sight, Sappington does not show or describe an adjustment member that may be removed without rendering inoperable the bow sight described by Sappington. Further, the Sappington device does not describe a removable adjustment member that functions in the same way as the claimed removable adjustment member. The brackets 83 and 89, slide 51, support 101, screws 43 and 121, threaded knob 133, threaded cap 73 and other components must all be assembled together before the sight 81 can be adjusted in a vertical or horizontal direction relative to a fixed point on the bow.

Applicant is not using the claim limitation removeable to mean that the device may be disassembled. The specification provides several indicators of what is meant by the claim limitation removeable adjustment member. For example, at page 1, lines 10-12, the specification indicates that "[t]he adjustment member is separable from the frame of the bow sight without affecting the position of the aiming point on the bow sight, thereby reducing the weight of the bow sight, and providing for increased rigidity in the bow sight." If the structure on the Sappington device that the office action has construed as the removeable adjustment member is separated or removed, the position of the aiming point is affected; more particularly, by removing the adjustment member from Sappington, the aiming point is also removed.

The specification also explains at Page 5, lines 24-28, "[w]hen the sight has been moved the desired amount, the set screw 54 is tightened and the pins 72, 74, and 76 pulled from the apertures of the slide 26 and the slide mount 28. If the user desires to again adjust the vertical position of the sight 32, the adjustment member 30 is again

engaged to the slide 26 and slide mount 28 and the sight 32 may be adjusted by the next sequential finite increment.”

Additionally, by disassembling or removing the “removable adjustment member” of Sappington, identified in the office action (the bracket 83, slide 51, support 101 and bracket 89 the sight 81) the horizontal bar is no longer engaged with the vertical slide or vertical slide mount – a limitation required in the pending claims.

Although the office action attempts to identify structure in the cited reference corresponding with each claimed limitation, the cited reference is not enabling. Unlike the bow sight shown and described by Sappington, the bow sight of the present invention includes a claimed removable adjustment member that provides finite incremental adjustment of the sight in both a horizontal and vertical direction. Even when the claimed adjustment member is removed, the sight of the present invention is usable by the archer to aim the arrow at the target. Removal of the claimed adjustment member does not require disassembly of the sight. The claimed aiming device of the present invention remains operable after the adjustment member is removed.

The office action asserts that [a]lthough the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.” However, removable adds a structural limitation to the type of structure that qualifies as a removable adjustment member. The scope of a claim term may be defined by the applicant in the specification, and the specification then limits the scope of the claim. *Astrazeneca AB v. Mutual Pharmaceutical Co.* 72 USPQ.2d 1726 (Fed.Cir. 2004). In this case applicant is being his own lexicographer and the claim limitation “removeable adjustment member” requires a structure that can be removed or is separable from the

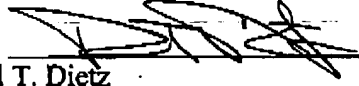
sight without disassembling the device and rendering the device inoperable. See, for example, support in the specification for this definition at page 10, lines 8-10, "[t]he adjustment member is separable from the frame of the bow sight without affecting the position of the aiming point on the bow sight."

A component or claimed feature is not removable if removing the element renders the device inoperable. Sappington does not show or describe a removable adjustment member that can be removed without rendering the described device inoperable. Further, a reference does not anticipate the claimed invention if the reference does not show or describe an operable device having the claimed element. Each independent claim of the present invention requires a removable adjustment member. A prior art reference does not anticipate a claimed invention simply by possessing identically named parts. A device neither anticipates nor renders obvious the invention if, in an attempt to satisfy each claimed limitation of the invention, the device is rendered inoperable. *In re Gordon et al.* 221 USPQ 1125 (Fed. Cir. 1984). "While experts may use the same words to describe both the claimed device and a prior art device, the prior art cannot anticipate the patent simply by possessing identically named parts, unless these parts also have the same structure or otherwise satisfy the claim limitations, and were understood to function in the same way by one skilled in the art." *Applied Medical Resources Corp. v. United States Surgical Corp.* 47 USPQ.2d 1289, 1293 (Fed. Cir. 1998).

Sappington does not include all the claimed essential elements and is rendered inoperable if construed to include a removeable adjustment member. Each independent claim requires a removable adjustment member that adjusts the aiming sight in controlled, finite, repeatable, increments in the horizontal and vertical direction relative to

a fixed point on the bow. Removable does not mean and cannot properly be construed to mean disassemblable. Therefore, each independent claim and claims dependent thereon are believed to be in a condition of allowance and a notice to that affect is respectfully requested. Applicant further notes that the office action fails to identify prior art that shows or describes the independent claims in combination with each of its depending claims. Each dependent claim includes limitations that are not shown or described in the cited references.

In view of the foregoing applicant believes pending claims 1-8, 10, and 15-17 are in a condition of allowance and a notice to that affect is respectfully requested.

By: 
Paul T. Dietz
Reg. No. 38,858
952-201-2008

Please address all correspondence to:
Paul T. Dietz
4975 Wilderness Lake Circle
Elko, MN 55020-9612
Phone: 952-201-2008

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CERTIFICATION UNDER 37 C.F.R. 1.8

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Paul T. Dietz